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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,648	02/15/2001	William Melo	71525-255379	5561

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EXAMINER

KESACK, DANIEL

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/784,648	Applicant(s) MELO ET AL.	
	Examiner Dan Kesack	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/15/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Original claims 1-25 are currently pending.
The rejections are as stated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 6, 9-11, 13, 16, 18, 20, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kroll et al., U.S. Patent No. 5,258,906.

Claims 1, 3, 9, 10, 16, 18, 23, Kroll discloses a device and method for automatically invoicing and crediting the user of a system from a location remote from the system, including circuitry to maintain usage information representative of cumulative customer usage associated with a device over a time period, storing said usage information on circuitry (column 3 lines 53-61), processes for transmitting a print job through a data communication network to a billing destination at a premises of the

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customer, including commands for printing an invoice amount based on the usage information and billing contract rules, retrieving said usage information, and determining an invoice amount based on stored rules (column 3 line 62 – column 4 line 14).

Claim 6, 13, 20, Kroll teaches the invoice amount being based on cost components, at least one of the cost components being based upon usage information (column 7 lines 31-43).

Claim 11, Kroll teaches the use of a modem as the communications device over the communications network (column 3 lines 35-36).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kroll, as applied to claim 16 above.

Kroll fails to teach using a proxy server to transmit data over the communications network.

Official notice is taken that proxy servers are old and well known in the art. Proxy servers transmit information across a network more efficiently, and more securely than direct network connections. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify Kroll to include the use of a proxy server in order to obtain the benefits of efficiency and security.

7. Claims 2, 4, 7, 8, 14, 15, 17, 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroll et al. as applied to claims 1, 9, and 16 above, and further in view of Gillbury, U.S. Patent No. 5,870,140.

Claims, 2, 17, Kroll fails to teach polling the device for usage information, having the circuitry for storing usage information.

Gillberry teaches a method for the central computer to poll each device over a communications link (column 10 lines 15-18 and claim 14). It would have been obvious

to one of ordinary skill in the art at the time of the Applicant's invention to modify Kroll to include polling the device for usage information because this would help detect problems in a timely manner, and would provide periodically updated usage information, without the need for a user request, further automating the method and apparatus.

Claims 4, 24, Kroll fails to teach storing usage information and billing destination in an external controller.

Gillberry teaches circuitry for storing usage information and billing destination in an external controller (column 9 lines 1-4, figures 1, 2). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the invention of Kroll to include storing the usage data and billing destination in the external controller because this is more secure, and helps with reliability because the data is housed in a centralized location.

Claims 7, 8, 14, 15, 21, Kroll fails to teach having the leaser of the device or the service contractor for the device as one of the billing party and determining the service schedule based on the information indicative of the amount of usage of the device.

Gillberry teaches having the leaser or service contractor of the device as one of the billing party and determining a service schedule based on usage information. (column 10 lines 37-48). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Kroll to include having the leaser or the service contractor as the billing party because the leaser or the service

contractor owning the device would have the most direct interest in that device, and would therefore be the billing party in a case where another entity is using the device for a fee. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Kroll to include determining a service schedule based on usage because the service contractor would be able to service the equipment in a timely manner, and when it is most needed, at a predetermined time based on usage of the device.

8. Claims 5, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroll et al. as applied to claims 1, 9, and 16 above, and further in view of Savage et al., U.S. Patent Application Publication No. 2002/0026394.

Claims 5, 12, 19, Kroll fails to teach the step of maintaining the usage information for distinct accounts defined by the customer having the invoice indicate a total invoice amount and portions thereof applied to each of the accounts.

Savage teaches a method of aggregating account charges for a customer on plurality of customer accounts and presenting a combined billing for the customer (claims 1 and 2).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify Kroll to include these steps taught by Savage because it creates a more manageable, convenient, customer-friendly interface for a client with multiple accounts, such that all invoices may be checked and completed in a single transaction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HANI M. KAZIMI
PRIMARY EXAMINER